

REMARKS

Applicant respectfully requests reconsideration of this application, and reconsideration of the Office Action dated December 3, 2003 (Paper No. 12). Upon entry of this Amendment, claims 1-17 will remain pending in this application. Claims 1-11 are withdrawn. The amendments to the claims are supported by the specification and original claims. Specifically, the changes to claim 12 are supported by page 8 of the specification and Figs. 6 and 7. No new matter is incorporated by this Amendment.

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Claims 12-17 are rejected under 35 U.S.C. § 112, second paragraph, as purportedly indefinite. Applicants respectfully traverse.

The Office Action asserts that the structure of the second layer is unclear. In response, Applicant respectfully submits that claim 12 describes the second layer as being a thin tubular film of plastic material that has a longitudinal cut extending the entire longitudinal length of the film so as to form at least one foldable free flap. In other words, the second layer is a tubular film of plastic that has been cut along its entire longitudinal length so that it can be opened to receive, for example, a food product. Applicant submits that the structure of the second layer would be readily ascertainable to those of ordinary skill in the art. Hence, claim 12 fully complies with 35 U.S.C. §112.

The Office Action also asserts that there is no antecedent basis for the terminology “the first component.” In response, claim 17 has been amended to recite “the first layer” which has antecedent basis from claim 12.

The above remarks overcome this rejection. Withdrawal of the rejection is thus respectfully requested.

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Claims 12-16 are rejected under 35 U.S.C. § 103(a) as purportedly obvious based on Spiegel (U.S. Pat. No. 3,764,002). Applicants respectfully traverse.

Independent claim 12 (from which claims 13-17 all ultimately depend) concerns a composite double-layer packaging material, for containing a food product. The packaging material includes a first paper support layer having a first surface and a second surface, and a second layer adhered to and substantially covering the first surface of the first layer. The second layer is a thin tubular film of plastic material. The thin film has a longitudinal cut extending an entire longitudinal length of the film so as to form at least one foldable free flap. Moreover, the packaging material is foldable and rollable such that the first layer rolls to surround the second layer and a food product received in the second layer with substantially only the second surface of the first layer exposed.

Applicant again points out that Spiegel discloses a card package comprising a card and a heat shrinkable tube. In Spiegel's invention, a shrinkable tube is adhered to a card, a bottle is then placed in the shrinkable tube, and heat is applied to the shrinkable tube to cause the tube to shrink around the bottle. Spiegel neither teaches nor fairly suggests a package material having all of the structural features recited in claim 12.

As an initial matter, claim 12 recites that the thin film has a longitudinal cut extending an entire longitudinal length of the film so as to form at least one foldable free flap. Spiegel neither teaches nor fairly suggest that the shrinkable tube includes a longitudinal cut extending an entire longitudinal length of the tube so as to form at least one foldable free flap. In fact, cutting the heat shrinkable plastic would destroy the invention of Spiegel for its intended purpose. The M.P.E.P. teaches, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. 2143.01. Applicant thus submits that not only does Spiegel fail to teach at least the longitudinal cut feature of the claim 12, but Spiegel fails to provide the requisite motivation to those of ordinary skill in the art to modify the teachings of Spiegel to employ such a cut.

The Office Action asserts that the card layer of Spiegel is equivalent to the claimed first layer. However, this is not an accurate interpretation of Spiegel. Spiegel teaches that the card can be made of conventional card board, plastics or metal. *See Column 3, Lines 25-30*. In contrast, claim 12 recites that the first layer is made of paper. Moreover, the claim recites that the packaging material (which includes the first paper layer) is foldable and rollable. Hence, Spiegel's substantially rigid card is structurally different from the paper lay of the present invention.

Spiegel describes certain embodiments as employing a card that can bend around the bottle enclosed in the shrink wrap (i.e. see Figs. 5B, 6A-B, 7B). However, in the embodiments shown in Figs. 5B and 7B, the shrink wrap surrounds the container and the card and causes the card to bend as the shrink wrap is heat-shrunk. Furthermore, the embodiment shown in Figures 6A-B does not include a tubular sleeve of a thin film of plastic. Thus, Applicant again respectfully submits that none of the embodiments described by Spiegel describes or fairly suggests each and every feature of claim 12.

Applicant appreciates that the Examiner is entitled to give each feature of a claim the broadest interpretation to which it is entitled. However, Applicant gently reminds the Examiner that the claims must be given their broadest reasonable interpretation consistent with the specification. Furthermore, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach (emphasis added). *See* M.P.E.P. § 2111. Applicants submit that those of skill in the art would not take the substantially rigid cardboard card employed by Spiegel to be equivalent or even suggestive of the of flexible paper layer of claim 12. Those of skill in the art simply would not recognize Spiegel's substantially rigid card as rollable and foldable as is Applicant's claimed packaging material. As has been previously explained, Spiegel's card package comprises a substantially rigid card and a heat shrinkable tube. The card package disclosed by Spiegel is used to hold containers, such as a bottle. In Spiegel's invention, a shrinkable tube is adhered to a rigid card, a bottle is then placed

in the shrinkable tube, and heat is applied to the shrinkable tube to cause the tube to shrink around the bottle. The product of Spiegel is used for suspending a container. If Spiegel's card were rollable and foldable, it would render Spiegel's card package useless for its intended purpose. While the Office Action has asserted that Spiegel's substantially rigid card would be rollable and foldable, Spiegel does not teach that the card is rollable and foldable. Moreover, there is nothing in the teachings of Spiegel which would suggest to one of ordinary skill in the art that Spiegel's card is rollable and foldable as is the paper layer of claim 12. Moreover, the conclusion that Spiegel's card would be rollable and foldable appears to be improperly based on hindsight.

To establish a *prima facie* case of obviousness, the Examiner must provide factual support from the cited patents for the proposed modification or combination. This factual support must be based on objective evidence of record and must establish that the cited patent itself provides the requisite motivation, suggestion, or teaching regarding the desirability of making the specific combination made by the Applicant. The factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. It is improper to determine whether a person of ordinary skill would have been led to modify the prior art based upon hindsight. In re Sang Su Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

In view of the above remarks, Applicants respectfully submit this rejection is overcome. Hence, reconsideration and withdrawal of the rejection is requested.

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Claim 17 is rejected under 35 U.S.C. § 103(a) as purportedly obvious based on Spiegel in view of Ferrero (U.S. Pat. No. 4,589,553). Applicants also respectfully traverse this rejection.

The deficiencies of Spiegel are discussed above. Nothing in the teachings of Ferrero remedies these deficiencies. Neither of the cited documents teach or fairly suggest a packaging material having a thin film that has a longitudinal cut extending an entire longitudinal length of

the film so as to form at least one foldable free flap. Moreover, neither patent teaches or fairly suggests a packaging material that is foldable and rollable such that the first layer rolls to surround the second layer and a food product received in the second layer with substantially only the second surface of the first layer exposed.

In view of the above remarks, Applicants respectfully submit that this rejection is overcome and request that it also be reconsidered and withdrawn.


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Applicant respectfully submits that this Amendment and the above remarks obviate the outstanding rejections in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees under 37 C.F.R. §§ 1.16 or 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 034001.003.

If an extension of time under 37 C.F.R. § 1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 034001.003.

Respectfully submitted,
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